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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,715	08/22/2001	Hideaki Takahashi	SON-2200	6288

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EXAMINER	
KESACK, DANIEL	

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/933,715	TAKAHASHI ET AL.	
	Examiner	Art Unit	
	Dan Kesack	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed. Original claims 1-17 are currently pending. The rejections are as stated below.

Priority

2. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the

application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge

under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 9, 10, 16, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, the phrase "upper limit service" renders the claim indefinite because one is unable to determine what is considered to be an "upper limit service" from the claim language, and therefore the scope of the claim is undeterminable.

Claims 9, 10, 16 and 17 recite "apparatus provides the first (second) privilege information in accordance with the degree of contribution to a business," and "[in accordance with] the degree of credibility that the user has acquired." It is unclear how the information is provided "in accordance" with either of these "degrees". The claim

language does not provide a clear definition of what steps or components must be present in order to meet the limitation of being "in accordance with" said "degrees".

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 101 because 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added).

Claims 1 and 11 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the claimed invention as a whole does not accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." See State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. The mere fact that the claim performs managing and converting of data does not satisfy the requirement of 35 U.S.C. 101. The claim may be interpreted in an alternative as involving no more than a conversion of data and therefore is non-statutory under 35 U.S.C. § 101. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical

application. In light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-7, 9-12, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel et al, U.S. Patent No. 6,594,640.

Claims 1, 11, Postrel discloses a system for electronic barter, trading, and redeeming points accumulated in frequent use reward programs, comprising a first and

second management apparatus for managing a first and second privilege information (column 5 lines 15-36, figure 4), wherein one management apparatus (trading server) converts the privilege information managed by the other management apparatus (credit card, airline, or marketing server), into information to be managed by itself, and manages the information obtained by the conversion (column 6 lines 25-38). While Postrel does not explicitly teach transactions of the first management apparatus being conducted in a "virtual world" or transactions of the second management apparatus being conducted in a "real world", Postrel teaches the transactions being credit card transactions and airline ticket purchases, either of which is conducted both in a real world environment and in a virtual world environment. Therefore it would be obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the teachings of Postrel to include transactions which are conducted in the "real world" and in the "virtual world".

Claims 2, 3, 5, 12, 15, Postrel teaches the privilege information is an addable point (column 6 lines 37-40), which is redeemable for service (column 1 lines 13-15).

Claim 4, Postrel teaches the conversion of privilege information taking place in response to a request from the user (column 4 lines 6-11).

Claim 6, Postrel teaches the second management apparatus performing settlement processing in response to a settlement request about a transaction that the user has conducted (column 7 lines 31-41).

Claim 7, Postrel teaches the second management apparatus performs the processing of issuing the point (column 5 lines 11-20).

Claims 9, 16, In light of the 35 U.S.C. 112 rejection stated above, for the purposes of examination, the claim language will be interpreted to mean the privilege information contains some indication of the amount of reward received. Postrel teaches the first management apparatus providing the privilege information (column 7 lines 31-41).

Claims 10, 17, In light of the 35 U.S.C. 112 rejection stated above, for the purposes of examination, the claim language will be interpreted to mean the privilege information contains some indication of the amount of reward received. Postrel teaches the second management apparatus providing the privilege information (column 6 lines 25-37).

9. Claims 8, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel et al., as applied above, and further in view of Chen, U.S. Patent No. 6,549,912.

Postrel fails to teach using identification information of the user that is stored in an IC card to process reward points.

Chen discloses a loyalty file structure for smart cards wherein user identification information relating to a loyalty program is stored on a smart card (figures 3, 4). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Postrel to include storing identification information on a smart card because the environment in which Chen implements the disclosed invention is identical to the operational environment of Postrel, and the smart card identification of Chen provides a convenient way for a card holder to identify himself or herself, and convenience is a desirable feature in the current invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HANI M. KAZIMI
PRIMARY EXAMINER